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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,119	05/04/2001	Donald E. Ackley	264/036	1949
34263	7590	12/03/2003		
O'MELVENY & MEYERS 114 PACIFICA, SUITE 100 IRVINE, CA 92618			EXAMINER MARSCHEL, ARDIN H	
			ART UNIT	PAPER NUMBER
			1631	
DATE MAILED: 12/03/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/849,119	<b>Applicant(s)</b> ACKLEY ET AL.	
	<b>Examiner</b> Ardin Marschel	<b>Art Unit</b> 1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 and 56-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-35 is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-19, 36-53 and 56-73 is/are rejected.
- 7) ☒ Claim(s) 12-14, 20, and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

Applicants' arguments, filed 9/12/03, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### PRIOR ART

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11, 15-19, 36-53, and 56-73 are rejected under 35 U.S.C. 102(b) and (e)(2) as being clearly anticipated either by Stettner et al. (P/N 5,696,577) or Wertz et al. (P/N 4,448,534).

This rejection is maintained and reiterated from the previous office action, mailed 7/9/03. Applicants firstly argue that the array itself of Stettner et al. is not adapted to receive a conductive solution and then discuss details of chip 7 as it is located in an enclosure etc. This argument is non-persuasive there is not seen any instant claim limitations which limit the extent of what is meant therein as to an array. Therefore, an

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array is reasonably interpreted as in the reference as being a structure with optionally numerous elements therein. Thus, an enclosure with other elements therein such as a tube 80, fiber optic material, etc. is reasonably included as a complex type of array which is not excluded via the broad instant claim wording. The argument further directed to chip 7 solution contact per se, or not, with a solution is also an argument directed to a part of what is reasonably an array which as a whole still is adapted to contact and thus receive a conductive solution as in the instant claims. Applicants then go on to argue that an electrode with circuitry for receiving and providing current thereto is not disclosed in Stettner et al. but then note that a metal anode of PIN diode is disclosed which collects an amplified electrical signal and is then connected to a storage capacitor. This argument is also non-persuasive because firstly the amplification of signals supports the interpretation that circuitry has received as well as provided electrical current to be amplified and utilized in the detection circuitry of the reference. Thus current supplying as well as current generation is performed in the reference contrary to the arguments of applicants. This argument is therefore non-persuasive. Applicants then argue that the column and shift registers of Stettner et al. only accesses the unit cell electronics and does not actively operate the unit cells. In response, this access does activate the electronics to obtain an output from the unit cells and thus reasonably does, in fact, actively operate the unit cells contrary to the arguments of applicants.

Similarly, the rejection based on Wertz et al. is reiterated and maintained from the previous office action, mailed 7/9/03. Similar to the above argument, applicants

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argue that the array of Wertz et al. is not adapted to receive a conductive solution. As above, in response the instantly claimed array is not limited as to the extent of what is included or excluded therein. Thus, the array being inclusive of the liquid sample multi-well tray in an array assemblage is included as a type of array as instantly claimed.

Thus, this argument is non-persuasive. Applicants then argue that Wertz et al. does not disclose electrodes which are supplied with current via circuitry. In response, the Wertz et al. photocell array therein is electrically connected to sensing circuitry. It is well known that electrical connections of this type must complete a closed loop in order to permit electrical current flow. This closed loop circuitry has two (2) connections through which any current flows during sensing practice. Thus, current both flows into as well as out of each cell of such a photocell array as is also instantly claimed.

Applicants further argue that the column and row selectors are external to and operatively connected to the array and do not drive the array unit cells. Similarly, from above, the connecting column and row selectors result in making the current flow connections during sensing in the array thus also disclose these instant claim limitations. Lastly, applicants argument that the photocells of the reference are not electrodes is non-persuasive for two reasons. Firstly there is no instant electrode definition which excludes such unit cells as being electrodes. Secondly, the array unit cells of Wertz et al. result in electrical flow in response to stimuli which reasonably is a type of electrode.

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### **CLAIM OBJECTIONS**

Claims 12-14, 20, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 22-35 are allowed.

**THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.


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Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

November 28, 2003

  
ARDIN H. MARSCHEL  
LEGAL INSTRUMENT EXAMINER